

Amendment and Response

Applicant: Daniel J. Fisher

Serial No.: 10/821,068

Filed: April 8, 2004

Docket No.: M120.229.101 / 59692US002

Title: CONVERSION PAD WITH MOISTURE BARRIER

REMARKS

These remarks are made responsive to the Non-Final Office Action mailed July 11, 2005. In that Office Action, the Examiner rejected claims 1, 2, 4, and 5 under 35 U.S.C. §102(b) as being anticipated by Manor et al., U.S. Patent No. 5,807,161 ("Manor"). Claims 3, 6, and 7-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Manor in view of Chelsey et al., U.S. Patent No. 5,785,784 ("Chelsey").

With this Response, claims 1 and 7 have been amended, and newly presented claims 12-19 added. Claims 1-19 remain pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §§102, 103 Rejections

As amended, independent claims 1 and 11 recite a conversion pad for attaching an abrasive article to a back-up pad otherwise attached to a sanding tool. In contrast, Manor is not a conversion pad. Pointedly, Manor specifically seeks to eliminate the need for a conversion pad (Manor at col. 1, l. 57 – col. 2, l. 3). For this reason alone, Manor does not teach or suggest the conversion pad set forth in claims 1 and 11 (and all claims depending therefrom), and in fact, teaches away from conversion pads.

In addition, amended claim 1 recites a moisture barrier arranged on a backing material. The Office Action asserts that the body 12 of Manor is a "moisture barrier". However, nothing in Manor teaches or suggests that the materials used as the molded body 12 are moisture barriers (e.g., col. 5, ll. 42-64). Simply stated, Manor is unconcerned with possible implications of moisture interaction (or absence of moisture) with the plate 17, such that Manor cannot be viewed as teaching or suggesting a moisture barrier. For at least these reasons, then, it is respectfully submitted that claim 1, and claims 2-6 depending therefrom, are allowable over Manor alone or in combination with Chelsey.

In addition to claiming a conversion pad (and thus distinguishable over the back-up pad of Manor), claim 7 recites a vulcanized fiber board supporting layer. As agreed by the Examiner, Manor does not teach a vulcanized fiber board supporting layer. Instead, the Office Action alleges that vulcanized fiber board would be an "obvious design choice". Applicant

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respectfully disagrees. The Office Action provides no prior art teaching of vulcanized fiber board; thus, there is no support for the assertion that vulcanized fiber board “would perform equally as well” as other materials described in Manor as being useful for the plate 17. Even further, no teaching or suggestion that vulcanized fiber board could be applied in back-up pad applications has been identified. In fact, vulcanized fiber board is not rigid enough to serve as the base material for a conventional back-up pad; back-up pads must be highly rigid to promote secured, mechanical attachment (e.g., screws or bolts) directly to a powered sanding tool. Thus, it is only with the pending application in mind that one of skill in the art might be lead to make the modifications of Manor advanced by the Examiner. As this hindsight “suggestion” cannot form the basis of a *prima facie* obviousness rejection, it is respectfully submitted that amended claim 7, and claims 8-11 depending therefrom, are allowable over Manor alone or in view of Chelsey.

Each of newly presented claims 12-17 depend from claim 1, and thus, for at least the reasons above, are allowable. In addition, claim 12 recites moisture barrier materials clearly not taught or suggested by Manor. Claim 13 recites a major surface configured for attachment to a back-up pad; as Manor is a back-up pad, claim 13 is further distinguished. Claim 14 recites that the moisture barrier is a coating; the injection molded body 12 of Manor is clearly in opposition to this limitation. Claim 15 recites a moisture proof layer. As described above, nothing in Manor positively teaches or suggests a moisture barrier, let alone a moisture proof layer. Claim 16 recites that the conversion pad is characterized by the absence of plate attachment holes, a feature required by the back-up pad of Manor (e.g., elements 18, 28). Finally, claim 17 combines several of the distinguishing limitations described above. Thus, claims 12-17 further define over Manor.

Newly presented claim 18 relates to a method of forming a conversion pad. The method includes coating first and second moisture proof layers to opposite sides of a backing material. In contrast, Manor does not describe making a conversion pad (and instead is limited to a back-up pad). Further, Manor does not contemplate, let alone teach or suggest, coating of moisture proof layers. Thus, it is respectfully submitted that claim 18 is allowable over the cited

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references. Similarly, claim 19 depends from claim 18 and recites further coating steps clearly not present in Manor.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-19 are in form for allowance and are not taught or suggested by the cited references. Therefore, consideration and withdrawal of the rejections and allowance of claims 1-19 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

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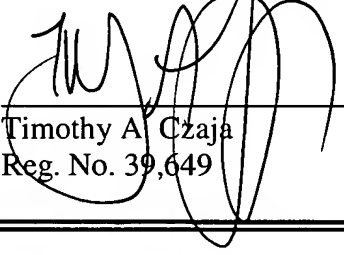
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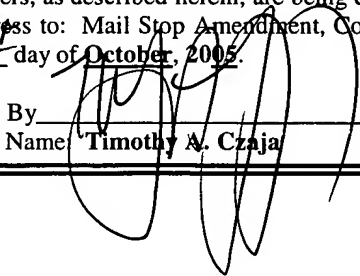
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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 11th day of October, 2005.

By 
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